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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/612,640	07/01/2003	Gi-Mo Yang	DE-1487	3684
7590	12/07/2004		EXAMINER DUONG, THOI V	
David A. Einhorn, Esq. Anderson Kill & Olick, P.C. 1251 Avenue of the Americas New York, NY 10020			ART UNIT	PAPER NUMBER
			2871	

DATE MAILED: 12/07/2004

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary	Application No. 10/612,640	Applicant(s) YANG ET AL.	
	Examiner Thoi V Duong	Art Unit 2871	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --
Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 03 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 01 July 2003.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-7 ~~is~~ are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-7 ~~is~~ are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☒ All b) ☐ Some * c) ☐ None of:
1. ☒ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____ |

DETAILED ACTION

Drawings

1. Figure 1 should be designated by a legend such as --Prior Art-- because only that which is old is illustrated. See MPEP § 608.02(g). Corrected drawings in compliance with 37 CFR 1.121(d) are required in reply to the Office action to avoid abandonment of the application. The replacement sheet(s) should be labeled "Replacement Sheet" in the page header (as per 37 CFR 1.121(d)) so as not to obstruct any portion of the drawing figures. If the changes are not accepted by the examiner, the applicant will be notified and informed of any required corrective action in the next Office action. The objection to the drawings will not be held in abeyance.

Claim Rejections - 35 USC § 102

2. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

3. Claims 1, 2, 3, 5 and 7 are rejected under 35 U.S.C. 102(b) as being anticipated by Tagawa (USPN 5,214,522).

Re claims 1 and 7, as shown in Fig. 4, Tagawa discloses a liquid crystal display device comprising a backlight 2 employing a light diffusing film 3 comprising:

a transparent substrate;

a light diffusing layer formed as a frosted glass on the surface of the transparent substrate (col. 3, lines 36-38); and

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a transparent conductive layer formed on the light diffusing layer (col. 3, lines 36-44),

wherein, re claim 3, the transparent conductive layer comprises at least one material selected from the group consisting of indium tin oxide (ITO), and stannic oxide (SnO₂).

Finally, as to the product-by-process limitation "by a dry coating process" of claim 1 and those recited in claims 2 and 5, it has been recognized that "Even through product-by-process claims are limited by and defined by the process, determination of patentability is based on the product itself. The patentability of a product does not depend on its method of production. If the product in the product-by process claim is the same as or obvious from a product of the prior art, the claim is unpatentable even though the prior art product was made by a different process". *In re Thorpe*, 227 USPQ 964,966 (Fed. Cir. 1985). See also MPEP 2113.

Claim Rejections - 35 USC § 103

4. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

5. Claim 4 is rejected under 35 U.S.C. 103(a) as being unpatentable over Tagawa (USPN 5,214,522) in view of Takamiya et al. (USPN 6,143,418).

Tagawa discloses a light diffusing film that is basically the same as that recited in

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claim 4 except for the thickness of the transparent conductive layer.

As shown in Fig. 1, Takamiya et al. discloses a transparent conductive film 1 having a thickness within the range of 5-200 nm so as to obtain good transparency while retaining sufficient static prevention effects and electromagnetic shielding effects (col. 9, lines 37-48 and col. 18, line 59 through col. 19, line 4).

Thus, it would have been obvious to one having ordinary skill in the art at the time the invention was made to modify the light diffusing film of Tagawa with the teaching of Takamira et al. by forming a transparent conductive layer having the thickness from 5 to 200 nm for obtaining good transparency while retaining sufficient static prevention effects and electromagnetic shielding effects (col. 9, lines 37-48).

6. Claim 6 is rejected under 35 U.S.C. 103(a) as being unpatentable over Tagawa (USPN 5,214,522) in view of Applicant's Prior Art (Specification, page 2, lines 8-10).

Tagawa discloses a light diffusing film that is basically the same as that recited in claim 6 except for the light diffusing film having an electric resistance of 1,000 ohm or less.

In "Background of the invention," Applicant discloses that "it is known in the art that the film resistance should be less than 1000 ohm for adequate electromagnetic wave shielding" (Specification, page 2, lines 8-10).

Thus, it would have been obvious to one having ordinary skill in the art at the time the invention was made to modify the light diffusing film of Tagawa with the teaching of Applicant's Prior Art by forming a light diffusing film having an electric

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resistance of 1,000 ohm or less so as to obtain adequate electromagnetic wave shielding (Specification, page 2, lines 8-10).

Conclusion

7. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Thoi V. Duong whose telephone number is (571) 272-2292. The examiner can normally be reached on Monday-Friday from 8:30 am to 4:30 pm.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Robert Kim, can be reached at (571) 272-2293.

Thoi Duong



11/28/2004



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